

REMARKS

Claims

Claims 1–22 were originally presented and claims 23–24 were added via election & amendment filed March 11, 2008. Claims 1, 2, 4–8, 14 and 24 are under examination and claims 15–22 are withdrawn from consideration due to restriction/election. Claims 3, 9–13 and 23 are cancelled without prejudice or disclaimer. Claim 25 is added by this paper.

Claim amendments

Claim 1 recites the subject matter of claims 2 and 3. Amended claim 1 is further supported by the disclosure contained in, for example, page 1, ¶1 of the originally-filed specification.

Amended claim 2 is supported by the disclosure contained in, for example, paragraph [0010] of the published application.

New claim 25 recites the subject matter cancelled from claim 6.

Applicants respectfully submit that the amendments presented herein do not raise new matter. Entry thereof is earnestly solicited.

Rejection under 35 U.S.C. §112, ¶2

The Examiner is thanked for her careful reading of the claims. The forgoing amendments render the rejection of claims under this section moot. Withdrawal of the rejection is respectfully requested.

Rejection under 35 U.S.C. §102

The Office Action contends that Sauman's (*International Journal of Developmental Biology*, 1993) disclosure of cytochalasin-D anticipates the subject matter of claims 1, 9 and 10. Applicants respectfully disagree with this contention. However, it is submitted that the rejection is obviated in light of the forgoing amendments. More specifically, claim 3 was not rejected under this section and independent claim 1, in its amended form, incorporates the elements of original claim 3. Withdrawal of the rejection is respectfully requested.

Rejections under 35 U.S.C. §112, ¶1

Claims 1–14, 23 and 24 are rejected due to allegedly lacking sufficient written description of cells, substances, and/or component of the cytoskeleton. This rejection is respectfully traversed.

At the outset it is submitted that in light of the Examiner's statements at page 5 of the Office

Action regarding claim 3 satisfying the written description requirements, and incorporation of said claim into independent claim 1, the rejection, at least with respect to the written description of cytoskeletal components, is moot. Applicants' amendment of said claim is not to be construed with acquiescence to this or any other ground of rejection.

With respect to cells, the Office Action at page 6 concedes that "the specification has adequate written description of method of cell digestion of bacterial cells using the substance which is particular domains of EF-Tu molecule." Applicants' have amended the claims to recite bacterial cells. No agreement is to be implied. As such, the rejection of claims for alleged lack of written description of cells is also moot.

Applicants have further amended the claims to recite bacterial EF-Tu. This is not to imply that the original claim scope was problematic under US law. Applicants' claims satisfy the statutory requirements under §112, 1st paragraph as established under *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997)), wherein the Lilly Court held that "[a] description of a genus of cDNAs may be achieved by means of a recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus." In the instant application, the disclosure of representative species, for example, *E. coli* EF-Tu, which fall within the claimed genus of bacterial EF-Tu, provides more than an adequate written description of the claimed molecules.

Applicants have further reviewed the PTO's new Written Description Guidelines and submit that the present claims conform to exemplary claim 2 of Example 15 beginning on Page 51 of the *Training Materials* (Rev. 1, March 25, 2008). While applicants may not agree with the agency's interpretation of the elements necessary to meet the statutory requirements of 35 U.S.C. § 112, ¶1, nonetheless, the pending claims substantially conform to these.

In the aforementioned Example, it is taught that the exemplary specification discloses a working example in which a full-length cDNA was isolated from a mouse cDNA library. The complete cDNA sequence (SEQ ID NO: 1) and predicted amino acid sequence (SEQ ID NO: 2) are disclosed. The specification states that the cDNA encodes a novel protein that the specification refers to as the murine "Squeaker" protein. The specification discloses a method for isolating human and other mammalian Squeaker cDNA sequences. However, the specification does not disclose any working examples showing isolation of other Squeaker cDNAs, and does not disclose any cDNA sequences other than the mouse sequence.

The representative claims are as follows:

Claim 1. An isolated nucleic acid comprising a nucleic acid sequence encoding a mammalian

Squeaker protein.

Claim 2. (Analogous to present claims) The isolated nucleic acid of claim 1 wherein said nucleic acid sequence encodes mouse Squeaker protein.

The guidelines state that although claim 1 lacks adequate written description (because only mouse squeaker protein was disclosed), claim 2 satisfies the requirements set forth under §112, ¶1.

Since the instant claims are directed to bacterial EF-Tu and insofar as the sequences are disclosed and known (see for example, paragraph [0010] of the published application and the referenced article by H. Song et al., *J. Mol. Biol.* 285, 1245-1256, 1999), the subject matter of Applicants' claims is analogous to the exemplary claim 2 of the guidelines. The guidelines explicitly state that the subject matter of the claim (i.e., mouse squeaker protein) is adequately described. To sustain this rejection would thus be inconsistent with the USPTO's own published guidelines. Withdrawal of the rejection is respectfully requested.

Formal matters

(a) Sequence listing

Applicants are in the process of obtaining a sequence listing from a vendor. Insofar as the Office Action at page 3 notes that "the noncompliance with the [sequence listing] requirements did not preclude the examination of the application on the merits," abeyance from this requirement is respectfully requested. See, MPEP §714.02 (b).

(b) Drawings

The instant application is a US national stage under §371 of PCT/EP03/07068. Applicants have obtained and included herewith a copy of the originally-filed figures. As for the translation of the German text contained therein, Applicants have contacted a vendor specializing in such services. Applicants submit that at least the clarity of the images is much improved in the new set of drawings submitted herewith.

Applicant notes that at page 4, the Office Action asserts that the objections in the drawings cannot be held in abeyance. However, as stated under MPEP §714, "Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters, although the filing of drawing corrections in reply to an objection to the drawings cannot *normally* be held in abeyance. However, the line between formal matter and those touching the merits is not sharp, and the determination of the merits of an application may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter." The same is respectfully requested.

As for the sequence listing text in the drawings, Applicants direct the PTO's attention to MPEP §608.02, which explicitly states "Applications filed under 35 U.S.C. 371 are excluded from the prohibition from having the same tables and sequence listings in both the description portion of the specification and drawings." Withdrawal of the objection is respectfully requested.

(c) Specification

The objection of the specification for allegedly failing to correspond to the drawings is respectfully traversed. The Examiner is cordially requested to specifically point to portions of the brief description of the drawings section and/or examples section of the specification, wherein the alleged discrepancy has been noted. In any event, in view of the forgoing reasons, Applicant requests abeyance from this objection until the newly prepared sequence listing/drawings can be entered into the specification, as required under CFR §1.52(e).

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response to
Deposit Account No. 13-3402.

Respectfully submitted,

/Anthony J. Zelano/

Anthony J. Zelano, Reg. No. 27,969
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: SIMANDI-0002

Date: March 16, 2009